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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,507	09/29/2005	Kazumasa Hamamura	2007_0364	4233

7590 07/22/2008
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EXAMINER

NOLAN, JASON MICHAEL

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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07/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,507	Applicant(s) HAMAMURA ET AL.	
	Examiner JASON M. NOLAN	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12, 15-22, 26-31 and 33-37 is/are rejected.
- 7) ☐ Claim(s) 7, 13, 14 and 23-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to Applicants Response to Election/Restriction, filed 03/17/2008. Claims 1-31 & 33-37 are pending in the instant application. No new or amended claims are presented.

Response to Restriction

Applicants' election without traverse of Group I: Claims 1 (in part), 2-5, 6 (in part), 9-17, 18 (in part), 19-22, 26, 27 (in part), 28 (in part), 29-31, & 33-37: drawn to compounds and medical agents according to formula (I) wherein ring A is a benzene ring, is acknowledged. For this reason, the remaining, non-elected subject matter (Groups II-VI) is withdrawn from further consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

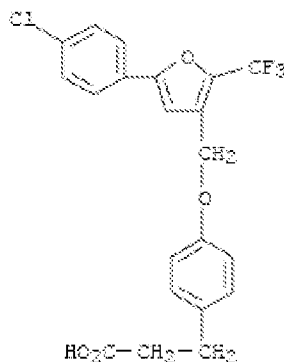
Claims 1-6, 8, 10, 11, 16, 30, 31, & 33-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Perrier *et al.* (US 6,020,339). Taught in the patent are pharmaceutical agents comprising aryl furan derivatives such as Examples 8, 23, 33, 38, & 43 which anticipate formula (I) wherein R1 = H; M4 = CH2; M1, Y, M2, M3, & X2 = bond; X1 = O; R2 = substituted aromatic group; p = 1; and R = substituted hydrocarbon

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group. The compounds described in the '339 patent are shown to be PDE IV inhibitors; however, if one of ordinary skill in the art were enabled to make and use compounds according to the formula (I) of the instant application, then that same person of ordinary skill in the art would be inherently enabled to make and use the compounds taught by Perrier et al. as pharmaceutical agents for regulating PPAR as claimed in claims 30, 31, & 33-37. For this reason, the compounds and pharmaceutical compositions of Perrier et al. anticipate claims 30, 31, & 33-37 without explicitly teaching their agents as useful as PPAR agents.

Claims 1-6, 8, 10-12, 16-18, 26-31, & 33-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Beswick et al. (WO 02/092590; *see* IDS). Taught in the reference are the compounds according to formula (I) in the abstract. Several species are contemplated within the scope of formula (I); for example: compound RN 476154-33-3, shown below, wherein X1 = O; R2 = substituted aromatic; R = substituted hydrocarbon; p = 1; M1 = CH₂; Y = O; M2 = bond; X2 = bond; M3 & M4 = CH₂; & R1 = H.

RN 476154-33-3 CAPLUS
CN Benzenepropanoic acid, 4-[[[5-(4-chlorophenyl)-2-(trifluoromethyl)-3-furanyl]methoxy]- (CA INDEX NAME)



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The invention taught in WO 02/092590 also contemplated hydrolysable esters (prodrugs) of formula (I) (p. 3, ll. 20) and the compounds were useful for pharmaceutical agents in the treatment of PPAR regulated diseases.

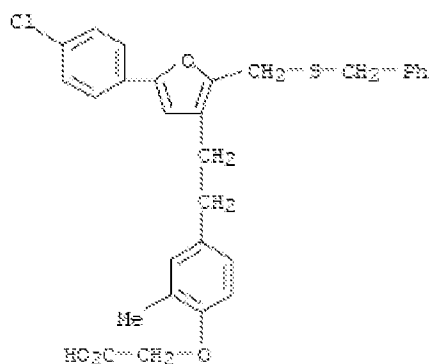
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 15, & 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beswick et al. (WO 02/092590; see IDS). Taught in the reference are the compounds according to formula (I) in the abstract. Several species are contemplated within the scope of formula (I); for example: compound RN 476156-39-5, shown below, wherein X1 = O; R2 = substituted aromatic; R = substituted hydrocarbon; p = 1; M1 = -CH₂CH₂; Y = O; M2 = bond; X2 = bond; M3 & M4 = CH₂; & R1 = H.

RN 476156-39-5 CAPLUS
 CN Acetic acid,
 Z-[4-{2-[5-(4-chlorophenyl)-2-[(phenylmethyl)thio]methyl]-3-furanyl]ethyl}-2-methylphenoxy]- (CA INDEX NAME)



The difference between the compound RN 476156-39-5 and Claims 9 & 19-22 (formula (I)) of the instant application is position of the substituents about the ring A. The substituents taught in WO 02/092590 and compound RN 476156-39-5 are para with respect to each other, whereas the substituents about ring A in the instant application are meta with respect to each other. Therefore, the instant compounds and the compounds of the prior art are positional isomers.

The difference between the compound RN 476156-39-5 and Claim 15 (formula (I)) of the instant application is M1. M1 is CH₂CH₂ in the compound RN 476156-39-5 and M1 is at least 3 or more carbon atoms. Therefore, the instant compounds according to Claim 15 are homologs of the compound RN 476156-39-5.

One skilled in the art would have found the claimed compounds *prima facie* obvious because it is well established that nothing unobvious is seen in positional isomers, since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. *In re Norris*, 84 USPQ 458 (1950).

Claim Objections

Claims 1, 6-8, 18, 23-25, 27, & 28 are objected to for containing non-elected subject matter (said claims recite subject matter wherein A is not a benzene).

Appropriate correction is required.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is Jason.Nolan@uspto.gov. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jason M. Nolan, Ph.D./

Examiner, Art Unit 1626

/Joseph K. McKane/
Supervisory Patent Examiner, Art Unit 1626